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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,037	08/23/2003	Steven G. Slesinski	1841-00001	1668
26659	7590	02/22/2005	EXAMINER	
DINNIN & DUNN, P.C. 2701 CAMBRIDGE COURT, STE. 500 AUBURN HILLS, MI 48326			HOGE, GARY CHAPMAN	
			ART UNIT	PAPER NUMBER

3611

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/647,037

Applicant(s)

SLESINSKI ET AL.

Examiner

Gary C Hoge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2,3,5,7-10,15 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,9 and 10 is/are allowed.
- 6) ☒ Claim(s) 3,5,7,8,15 and 18-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 November 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the panels having different horizontal widths such that one panel overlaps an opposite door when the doors are closed, as recited in claim 3, the brackets recited in claim 7, the hinges recited in claim 18, and the cutout region recited in claim 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings were received on November 22, 2004. These drawings are not approved for the reasons set forth below:

Regarding Fig. 1, Applicant states, "Applicant amended Figure 1 so it will show the panels being attached to the doors rather than the vehicle body. One skilled in the art would have recognized that the inadvertent error in Figure 1 would prevent the doors from opening. Furthermore, both page 4, lines 10-12 of the description and Figure 2 describe the panels 12 and 14 as being attached to doors 16 and 18 rather than the vehicle body." Applicant is correct that the description at page 4 supports the alteration made in Fig. 1, but Fig. 2 does not. Fig. 2 clearly shows the line between the door and the vehicle body, and the hinge therebetween. It also shows the bolt securing the corner of the sign to the vehicle body, not the door. Thus, the modification of Fig. 1 constitutes new matter.

Regarding Figs. 3 and 4, in order to avoid the issue of new matter when supplying new drawings, the original description must have been so complete as to allow for only one possible embodiment. In this case, Applicant has illustrated the right door being wider than the left door, but he could just as easily have illustrated the left door being wider than the right door. As it stands now, if a prior art reference existed that showed the left door being wider than the right door, Applicant could use his new Figs. 3 and 4 to define over that reference, even though the original disclosure did not specify which door was wider. Therefore, Figs. 3 and 4 constitute new matter.

Regarding Figs. 5 and 6, these drawings purport to show brackets attaching the panels to the door, but all they appear to show is the spacer of Fig. 2 with part of the bolt being removed. Besides, the original claim mentions only "brackets," and brackets can be made in a nearly unlimited variety. Therefore, any specific bracket Applicant might choose to illustrate would constitute new matter.

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Regarding Figs. 7 and 8, the specific hinge types and their specific locations on the panel and the vehicle were not disclosed. Therefore, the attempt to illustrate them now constitutes new matter.

Regarding Fig. 9, this drawing does not correspond to what was described in the specification. On page 6, the specification states, "This clearance [between the panel and the door] accommodates a vertical sliding locking bar 30, used in many cargo vehicles to secure the rear doors. An alternative embodiment (not shown) includes a panel formed having a semi-circular or alternatively shaped 'cutout' region for accommodating the sliding bar 30." What is being described appears to be a panel that is thicker than the diameter of the sliding bar, and that has a semi-circular cutout in the back of the panel, but not extending all the way through, that accommodates the sliding bar.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "23" has been used to designate both the hinge (e.g., page 6, line 16) and a fastener (e.g., page 7, line 9). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The amendment filed November 22, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The recitation that “the attachment of the panel is not limited by Figures 7 and 8 as the attachment means can be secured to the roof, bumper, vehicle sides, or any other suitable location” is new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Objections***

5. Claim 3 is objected to because of the following informalities: on line 10, it appears that “on” should be “one”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 3, 7, 18, 19, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See the above objection to the drawings. The subject matter of these claims was not illustrated or described in detail in the specification.

Regarding Applicant's remarks, the Examiner does not deny that the subject matter of these claims was mentioned in concept form in the specification. Rather, the Examiner maintains that they were "not described in the specification *in such a way as to reasonably convey* to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In other words, Applicant mentioned the concept but did not flesh it out in a specific embodiment.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Norfleet.

Norfleet discloses an advertising assembly comprising a first panel 64 and a second panel 64. See Fig. 1. The first and second panels are mounted on left and right rear doors of a cargo storage area of a motor vehicle, and they have parallel inner edges that are substantially aligned when the left and right rear doors of the cargo storage area are closed. A plurality of spacers 72 are disposed between the panels and the doors.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norfleet.

Norfleet discloses the invention substantially as claimed, as set forth above. However, it is not known precisely what the dimensions of the panels are. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the panels about 40 inches by about 50 inches, because it has been held that disclosing an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

13. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norfleet in view of Pountney.

Norfleet discloses the invention substantially as claimed, as set forth above. However, the spacers disclosed by Norfleet are extended strips, rather than individual cylindrical members through which the fasteners extend. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Norfleet by substituting individual cylindrical spacers for the longitudinally-extending strips since Pountney teaches that these two spacer



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means are art recognized equivalents in the panel mounting art and the selection of any of these known equivalents would work equally well in the device of Norfleet.

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norfleet in view of Rumbarger.

Norfleet discloses the invention substantially as claimed, as set forth above. However, the sign disclosed by Norfleet is not electronic. Rumbarger teaches that it was known in the art to provide an electronic sign on a vehicle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sign disclosed by Norfleet electronic, as taught by Rumbarger, in order to draw attention to the sign.

#### ***Response to Arguments***

15. Applicant's arguments filed November 22, 2004 have been fully considered but they are not persuasive.

Regarding claim 5, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding claim 8, Applicant states, "claim 8 has been amended to add a further restriction that the display be unitary. While Ramburger [sic] does teach the placement of an electronic sign on a vehicle, it does not teach how to attach two electronic signs across the back door of such a vehicle to create a unitary display." But claim 8 was not rejected as being anticipated by Rumbarger. It was rejected as being obvious over Norfleet in view of Rumbarger. Norfleet discloses making a unitary display out of two separate sign elements across the back

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doors of a vehicle. Rumbarger teaches providing electric lights to a vehicle sign display. Therefore, the combination proposed by the Examiner is to provide the sign disclosed by Norfleet with electric lights, as taught by Rumbarger. This would result in the unified display claimed by Applicant.

It is noted that Applicant did not challenge the rejection of claim 15 as being anticipated by Norfleet.

It is noted that Applicant did not challenge the rejection of claim 20 as being obvious in view of Norfleet.

***Allowable Subject Matter***

16. Claims 2, 9 and 10 are allowed.

***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

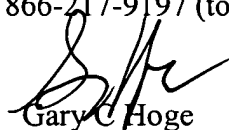
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C Hoge whose telephone number is (703) 308-3422. After April 5, 2005, the examiner's telephone number will be (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch